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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,337	09/10/2003	Willard C. Wacha	19080.04	1868
23405	7590	06/07/2006	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203			ARK, DARREN W	
		ART UNIT	PAPER NUMBER	
			3643	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/658,337	WACHA, WILLARD C.	
	Examiner Darren W. Ark	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,16-21,23-25,27-29,31,33-36 and 38-42 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,16-21,23-25,27-29,31,33-36 and 38-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 16, 17, 29, 34-36, 38-40, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830.

Marshall discloses a lip (11) with front (12) and back portions (portion of 11 rearward of 40), a strap (defined between 20 & 22) adapted to receive a fishing line (line is capable of being tied about the area between 20 & 22), a first aperture (24), a second aperture (at 18), a plurality of rigid ("rigid" is a relative term that does not set forth any specific physical property and the spurs are described as "wire-like" members at col. 4, line 21, therefore the wire-like members are can be interpreted as being rigid when compared to a thread or yarn) spurs (50), and the hook attached between the first and second apertures (24 and at 18 in Figs. 7, 8), but does not disclose the hook attached to the lip by molded material encasing an end of the hook and the area between the first and second apertures. Brott, II discloses a hook (14) attached to the lip (12) by molded material (16 of lead) encasing an end of the hook and a portion of the lip which includes a first (30) and second (50) apertures (see Fig. 7). It would have been obvious to a person of ordinary skill in the art to modify the device of Marshall such that the hook is

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attached to the lip by molded material encasing an end of the hook and the area between the first and second apertures in view of Brott, II in order to provide a means for permanently fixing the lip and hook together rigidly and positionally with respect to each other and also provides additional weight to the lip so as to sink more quickly and to greater depths.

In regard to claim 16, see col. 3, lines 20-31.

In regard to claim 17, Marshall and Brott, II discloses the lip made of metal but not of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because plastic can be molded in many different shapes, sizes, and configurations. *In re Leshin*, 125 USPQ 416.

In regard to claim 29, Marshall and Brott, II each discloses a strap (area between 20 & 22 of Marshall and area between 28 & 58 of Brott, II; the respective straps protrudes from the front portions of their respective lips, furthermore the straps are not being particularly claimed).

In regard to claims 36 and 38, Marshall discloses the spurs constitute bait holders (bait may be placed onto the spurs; the structure of the spurs is not being particularly recited) and are distinct from the hook (the spurs 50 of Marshall are separate parts assembled together with the hook under the head of the screw or bolt 40).

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In regard to claims 39 and 40, Marshall discloses the spurs (50) comprising a plurality of rigid projections or spikes (52, 54; "rigid" is a relative term that does not set forth any specific physical property and the spurs are described as "wire-like" members at col. 4, line 21, therefore the wire-like members are can be interpreted as being rigid when compared to a thread or yarn).

In regard to claim 42, Marshall discloses the strap (area between 20 & 22) being elevated with respect to the lip (the area between 20 & 22 extends higher than the rest of lip 11).

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830 as applied to claim 1 above, and further in view of Peters et al. 3,344,549 or Lievense 2,886,914.

Marshall and Brott, II do not disclose the lip made of plastic. Peters et al. and Lievense disclose the lip (25 or 1) made out of plastic (transparent or translucent plastic). It would have been obvious to a person of ordinary skill in the art to make the lip of Marshall and Brott, II such that it is made out of transparent or translucent plastic in view of Peters et al. or Lievense in order to provide a lip which is difficult to be seen by the fish.

4. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830 as applied to claim 1 above, and further in view of Wicht 5,588,247.

Marshall and Brott, II do not disclose the molded material being one of a non-toxic metal or a polymer. Wicht discloses the body (10), body extension (11), and cap

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(24) being formed from a non-toxic metal (lead-free brass) because of environmental concerns. It would have been obvious to a person of ordinary skill in the art to make the molded material or Marshall and Brott, II out of a non-toxic metal in view of Wicht in order to provide a sinker material which provides the necessary mass yet will not pollute the environment if lost.

5. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Brott, II 5,216,830 as applied to claim 1 above, and further in view of Perry 2,538,703.

Alternatively, Marshall and Brott, II do not disclose the lip made of plastic. Perry discloses a lip (11) with a punched out strap (25-27) which elevated with respect to the lip (see Figs. 1, 4). It would have been obvious to one having ordinary skill in the art to modify the lip of Marshall and Brott, II such that the strap is elevated with respect to the lip in view of Perry in order to provide a line attachment device wherein the line can be easily looped thereunder so as to allow the user to readily attach the line thereto.

6. Claims 18-21, 23-25, 27, 28, 30, 31, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Gibbs 2,700,240.

Marshall discloses a body (11 in Figs. 7, 8) with a lip portion (portion of 11 at and forward of 40 extending to 12) with a rounded outer edge (at 12) tapering into a substantially flat, narrow elongated neck portion (portion rearward of 40; transition between the lip and neck not particularly claimed) with parallel opposed sides (flat sides are parallel); a first aperture (at 18); means for receiving a line (22) comprising a punched out strap (22 along with forward edge of 20 defines a narrow area that is a

strap) protruding from the lip (the narrow area protrudes from the front of the lip); a second aperture (24 or 22); and means for promoting sinking when exposed to a flow of water comprised of a raised lip (concave shape of 12 defines outer edge which is raised higher relative to the rest of the surface; also weight of 40) and positioning of the lip portion such that it is non-planar with the neck portion (see Fig. 7); a plurality of spurs (50), but does not disclose the rounded outer edge tapering to substantially parallel opposed lateral sides of the narrow elongated neck portion. Gibbs discloses a rounded outer edge (outer edge of 1) tapering to substantially parallel opposed lateral sides of the narrow elongated neck portion (parallel sides of 6). It would have been obvious to a person of ordinary skill in the art to modify the rounded outer edge of Marshall such that it tapers to substantially parallel opposed lateral sides of the narrow elongated neck portion in view of Gibbs in order to provide a neck portion which looks gives the appearance of a body portion of a baitfish.

In regard to claim 18, Marshall discloses a plurality of rigid ("rigid" is a relative term that does not set forth any specific physical property and the spurs are described as "wire-like" members at col. 4, line 21, therefore the wire-like members are can be interpreted as being rigid when compared to a thread or yarn) spurs (50) projecting from the body (11).

In regard to claims 30 and 31, Marshall discloses the spurs comprise bendable wire (wire-like weedguards 52, 54) and are adapted to retain one of a second hook and bait (the spurs 52, 54 are capable of retaining one of a hook and bait since they have

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the necessary structure to have a hook or bait secured thereto; the spurs are not being particularly claimed).

In regard to claim 41, Marshall discloses the spurs (50) comprising a plurality of rigid spikes (52, 54; "rigid" is a relative term that does not set forth any specific physical property and the spurs are described as "wire-like" members at col. 4, line 21, therefore the wire-like members are can be interpreted as being rigid when compared to a thread or yarn).

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Gibbs 2,700,240 as applied to claim 18 above, and further in view of Perry 2,538,703.

Alternatively, Marshall and Gibbs do not disclose a punched out strap. Perry discloses a punched out strap (rib 26). It would have been obvious to a person of ordinary skill in the art to modify the means for receiving a line of Marshall and Gibbs such that it is in the form of a punched out strap in view of Perry in order to provide a means for receiving the line which extends outwardly from the surface of the lip so it is positioned to facilitate threading the line for engagement therewith.

### ***Response to Arguments***

8. Applicant's arguments filed 4/24/2006 have been fully considered but they are not persuasive.

In regard to applicant's argument that "...wire-like weedguard 50 of Marshall does not comprise a plurality of spurs as recited in claim 1 and disclosed in the instant

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application...comprise rigid projections and not simply flimsy wires...weedguard 50, are not spurs, as understood...but simply wires...", the Examiner contends that applicant has not particularly recited the spurs or projections of the desired invention in a manner which recites such structure over the wire-like members 50 disclosed by Marshall.

Examiner also argues that the wire-like members 50 of Marshall "project" from the lip/body from the area as claimed and that the term "spur" does not specifically entail any structure not shown or disclosed by Marshall.

In response to applicant's argument that "...claim 31 recites...spurs 'are adapted to retain one of a second hook and bait'...use as a bait holder...", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In regard to applicant's argument that "Patent Office's suggestion that the weedguard of Marshall be used as bait holders clearly interferes with the intended function of a weedguard...", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

*Ex parte Masham*, 2 USPQ2d 1647 (1987).

In regard to applicant's argument that "claim 1 recites that 'the punched out strap having two ends each attached to the lip'...Patent Office identifies the strip between hole 22 and edge 20...", the Examiner contends that the area between hole 22 and

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edge 20 of Marshall defines a small strap as claimed wherein the ends that are attached to the lip are one either lateral side of the hole 22. Applicant has not particularly defined the strap in any particular fashion which defines over the strap as disclosed by Marshall.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Marshall patent discloses the basic lure having a lip and spurs while the Brott, II patent was relied upon for its disclosure of the hook attached to the lip by molded material encasing an end of the hook and the area between the first and second apertures and the Gibbs patent was relied upon for its disclosure of the rounded outer edge tapering to substantially parallel opposed lateral sides of the narrow elongated neck portion.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In regard to applicant's comment that "Since the limitations of claim 29 were not addressed in the above referenced Office Action, the Applicant assumes that claim 29 recites allowable subject matter...", the Examiner directs applicant's attention to paragraph number 3 of the Office Action mailed 1/20/2006 which clearly states "Claims 1..29...are rejected" thereat. It is the Examiner's position that the limitations of claim 29 were not patentable since the lip of Marshall (between 22 & 20) protrudes from a front portion of the overall lip (11) and is the forwardmost or highest part of the lure assembly.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

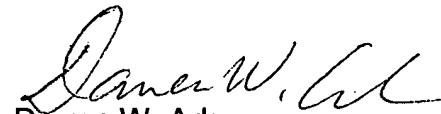
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (571) 272-6885. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark  
Primary Examiner  
Art Unit 3643

DWA